

REMARKS

This response to the Office Action mailed May 8, 2009 is believed to address all issues raised in the Action. Favorable reconsideration is respectfully requested.

Claim Status

Claims 1 and 3-14 are all pending in the application. Claim 1 is amended to incorporate the subject matter of claim 2 and claim 2 is canceled. Entry of the Amendment after final is proper since Applicants are merely combining claims.

Formal Matters

Applicants thank the Examiner for the telephonic interview conducted on May 13, 2009. As a statement of the substance of the interview, Applicants submit the following. Applicants argued that Table 1 of the original disclosure provides a conclusive showing of unexpected results. The Examiner disagreed by stating that the Ueda reference teaches a range of values between 90 and 100% and this range includes such a limited number of values that each point is described with sufficient specificity; however, the Examiner noted that Table 1 can provide a possible conclusive showing of unexpected results with respect to claim 2. Additionally, the Examiner indicated that the experiments having 99.6% cis 1,4 bond content in Table 1 are commensurate with the independent claim that requires at least 99.5% cis 1,4 bond content.

Response to Rejections under 35 U.S.C. § 103

On page 2 of the Action, the Examiner rejects claims 1-3, 5, 6 and 9-14 under 35 U.S.C. §103(a) as being unpatentable over Ueda (JP 59-196338) and further in view of Imamura (US 3,913,652) and Scriver (US 4,192,366). On page 3 of the Action, the Examiner rejects claim 7 under 35 U.S.C. §103(a) as being unpatentable over Ueda, Scriver and Imamura and further in

view of Inui (US 5,191,003). On page 4 of the Action, the Examiner rejects claims 1-6 and 8-14 under 35 U.S.C. §103(a) as being unpatentable over Segatta (US 5,396,940) and further in view of Imamura and Scriver.

Applicants submit that claim 1 has been amended to incorporate the specific rubber loadings of claim 2 and that the cited references fail to disclose or render obvious the present invention.

Currently amended claim 1 is characterized in that a ratio by mass of (A) the synthetic polyisoprene rubber to a total of (A) the synthetic polyisoprene rubber and (B) the natural rubber is 5-60 mass%. To the contrary, none of the cited documents, i.e., Ueda, Scriver, Imamura, Inui and Segatta teaches or suggests that the ratio by mass of (A) the synthetic polyisoprene rubber to the total of (A) the synthetic polyisoprene rubber and (B) the natural rubber is 5-60 mass%,

Furthermore, when the ratio of (A) the synthetic polyisoprene rubber is less than 5 mass%, the effect by compounding (A) the synthetic polyisoprene rubber is little and the balance between the dynamic properties and the processability is not improved. In addition, when the ratio of (A) the synthetic polyisoprene rubber exceeds 60 mass%, the wear resistance and the durability of the rubber composition are deteriorated and the adhesion property to a roll is also deteriorated (see paragraph [0019]). These unexpected results are not taught or suggested in any of the cited references.

Moreover, the above-mentioned unexpected results are fully supported by Table 1 in the present specification. In this regard, in the Interview Summary the Examiner states that "Table 1 can provide a possible conclusive showing of unexpected results with respect to claim 2".

Accordingly, all of Ueda, Scriver, Imamura, Inui and Segatta fail to disclose or render obvious the features of the present invention. Further, claims 3-14, all of which depend from claim 1 are patentable for the same reasons that claim 1 is patentable.

In view thereof, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103 rejections of claims 1 and 3-14.

In addition, Applicants have the following comments on the *cis* 1,4 content anticipation issue raised by the Examiner in the interview, as set forth in the Interview Summary. In particular, with respect to the recited *cis*-1,4-bond content range of not less than 99.0% (i.e., 99.0 to 100%) for the synthetic polyisoprene rubber, Applicants submit that contrary to the Examiner's assertion, the 90% or more range in Ueda does not disclose the claimed range with sufficient specificity to anticipate the claimed range. In this regard, Applicants note that MPEP 2131.03 II sets forth that "[i]f the claims are directed to a narrow range, and the reference teaches a broad range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims. See, e.g., *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006) wherein the court held that a reference temperature range of 100-500 degrees C did not describe the claimed range of 330-450 degrees C with sufficient specificity to be anticipatory." Thus, Applicants submit that if a 120°C range (i.e., 450°C-330°C) is not anticipated by a 400°C range (i.e. 500°C-100°C) even though it occupies 30% $((120/400) \times 100)$ of the disclosed range, the presently recited 1.0% range (i.e., 100%-99.0%) is not described with sufficient specificity by Ueda's 10% range (i.e., 100%-90%) since the recited range only occupies 10% $((1.0/10) \times 100)$ of the disclosed range. Thus, Applicants submit that the

AMENDMENT UNDER 37 C.F.R. § 1.116
Application No.: 10/562,947

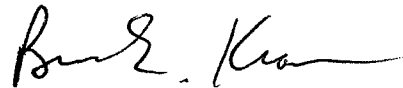
Attorney Docket No.: Q92273

Examiner's range anticipation position is inappropriate. The aforementioned analysis applies with even more force to the "not less than 99.6%" range recited in claim 13 and the "not less than 99.9%" range recited in claim 14. Accordingly, Applicants submit that there is no case of anticipation, even with respect to the range aspect of the claims, and thus a showing of unexpected results can properly be presented, as discussed above.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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